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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,582	01/04/2001	Hiroyuki Matsushima	201510US2	2026
22850	7590	11/10/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MOONEYHAM, JANICE A	
		ART UNIT	PAPER NUMBER	
		3629		

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/753,582	MATSUSHIMA, HIROYUKI	
	<b>Examiner</b> Jan Mooneyham	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 July 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 and 28-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 21, 2004, wherein:
  - Claims 1-25 and 28-32 are currently pending;
  - Claims 1-25 and 28-31 have been amended;
  - Claims 26 and 27 have been cancelled;
  - Claim 32 has been added.

#### ***Information Disclosure Statement***

2. The applicant states that the Office Action failed to provide an initialed and executed List evidencing consideration of the related case. The Examiner is providing copies of the initialed and executed List of the IDS(s) submitted on January 4, 2001, December 1, 2003, and February 11, 2003.

#### ***Specification***

3. The applicant has amended the abstract and the amended abstract has been placed in the file and the requirement for a new abstract is withdrawn.
4. A substitute specification was required but not supplied. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

***Response to Amendment***

***Claim Rejections - 35 USC § 112***

5. The applicant has amended Claims 1-25 and 28-31 and cancelled Claims 26 and 27.

Therefore, the original rejection as to Claims 1-31 under the second paragraph of 35 U.S.C. 112 is hereby *withdrawn*.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 1-5, 13-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent 5,914,472) (hereinafter referred to as Foladare).**

**Referring to Claims 1, 13 and 31:**

Foladare discloses a lending management system and medium comprising:  
a client terminal connected to a network (central computer contact means, card reading device Figs. 2, 3 (200), col. 4, lines 11-27, col. 6, line 58 – col. 7, line 22);  
a server terminal (central computer, (204)) connected to said network configured to be connected to an information device (ancillary transaction credit card) wherein said client terminal is configured to transmit to the server terminal via the network information related to the information device (col. 4, lines 58-63),  
said server terminal configured to receives information from said client terminal (Fig. 1, col. 4, lines 19-27), determines whether transaction (reservation ) (ancillary transaction card) is

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permitted (col. 4, lines 23-57), and registers the transaction (reservation) and transmits an information to said client terminal which indicates that the transaction (reservation) has been registered (col. 3, line 65 thru col. 4, line 57, col. 5, lines 9-35).

the client terminal comprises an image transmission designating unit configured to transmit an input image data from the information device.(col. 6, lines 4-10 – e.g. using a bank debit card, an image is presented in the display of the card swipe).

Foladare does not explicitly disclose that the information is in regard to a reservation. However, this is non-functional descriptive material since the information does not reconfigure the system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703, F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d. 1579, 32 USPQ2d 1031 (Fed Cir. 1994)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the information be reservation information because the type data does not functionally relate to the structure claimed and thus doe not patentably distinguish the claimed invention.

Foladare does not disclose a lending management system wherein the information is a reservation for a digital camera. However, the system disclosed in Foladare discloses a lending management system with the same problem as the applicant' and the same solution. The only difference is that Foladare discloses a smart card having users rights whereas the applicant is disclosing a digital camera having users rights.

**Referring to Claims 2 and 14:**

Foladare discloses a lending management system wherein the server terminal further comprises a user certification unit which authenticates a user's access right (Figs. 1-3, col. 3, lines 2- 42) and a permission unit to permit transaction (approval/refusal).

**Referring to Claims 3 and 15:**

Foladare discloses a lending management system wherein said user certification unit carries out the user certification by checking a user identification and password (Fig. 1, (101, 102) col. 2, lines 48-53).

**Referring to Claims 4 and 16:**

Foladare discloses a lending management system wherein said user certification unit is provided with a magnetic card reader (Fig. 1 (101, col. 4, lines 11-27)).

**Referring to Claims 5 and 17:**

Foladare discloses a lending management system wherein the user certification unit is provided a card reader (Fig. 1 (101), col. 4, lines 11-27).

7. **Claims 8-12, 20-24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent No. 5,914, 472) (hereinafter referred to as Foladare) in view of Shiota et. al (US 6,657, 660) (hereinafter referred to as Shiota) .**

**Regarding Claims 8 and 20:**

Foladare discloses a lending management system with the client terminal comprising an image transmission designating unit configured to transmit an input image data from the information devise (col. 6, lines 4-10). Foladare does not disclose a system wherein the client

terminal further comprises an image (picture) transmission designating unit for transmitting an input image data and a server terminal transmitting the input image data

However, Shiota discloses disclose a system wherein the client terminal further comprises an image transmission designating unit for transmitting an input image data, and a server terminal transmitt the input image data (Fig. 1)

It would have been obvious at the time of the invention to incorporate the teachings of Shiota into the disclosure of Foladare so that pictures recorded by a digital camera from a lending management network can be more easily stored and utilized by the user once the user is permitted to use the camera.

**Referring to Claims 9-12 and 21-24:**

Shiota discloses system wherein the image transmission comprises an electronic computer originated mail, wherein the image transmission employs a FTP (file transfer protocol) in a TCP/IP, wherein the image transmission comprises a file transfer command in a HTTP and further comprising a printing unit for printing the input image data (Fig. 1).

Furthermore, the examiner takes Official Notice that it is old and well known to employ FTP in a TCP/IP to transfer files,that HTTP file transfer commands are old and well known, and printing units for printing input image data are old and well known.

**Referring to Claim 25:**

Foladare discloses a lending management system. Foladare does not disclose a lending management system wherein the input image data is stored in the WWW server.

However, Shiota discloses a lending management system wherein the input image data is stored in the WWW server (Fig. 1).

It would have been obvious to incorporate the teachings of Shiota into the disclosure of Foladare so that pictures recorded by a digital camera can be more easily stored and utilized.

**Referring to Claim 32:**

Shiota discloses a system wherein said server terminal is configured to install a WWW server function therein to permit inspection of the input image ((Fig. 1), col. 2, lines 35-43, col. 3, lines 12-30).

**8. Claims 6, 7, 18, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladore et al (US 5,914,472) in view of Steinberg et al (US 6,433,818) (hereinafter referred to as Steinberg).**

**Referring to Claims 6 and 18:**

Foladore discloses a lending management system. Foladore does not disclose a lending management system wherein the user certification unit includes a fingerprint input unit. However, Steinberg discloses a user certification unit including a fingerprint input unit (Fig. 7, col. 2, lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the system of Foladore the teachings of Steinberg since it allows the lender the ability to restrict the use of the rental camera to only authorized users and provides the camera with a theft protection system.

**Regarding Claims 7 and 19:**

Steinberg further discloses a lending management system wherein the device is provided with a lock switching unit for switching operation possible/operation impossible in accordance with an input signal (col. 2, lines 3-37)

wherein said server terminal transmits a lock release signal (col. 2, lines 20-29, Fig. 1)

**Regarding Claim 28:**

Foladore discloses method comprising:

authenticating the user's identification and password ((Fig. 1, (101, 102) col. 2, lines 48-53).

Foladore does not disclose:

confirming the reservation

releasing the lock of the device.

However, Steinberg discloses:

confirming the reservation (rental) (col. 1, line 66 thru col. 2, line 2, col. 2, lines 39-45,

Fig. 7)

releasing the lock of the device (col. 2, lines 3-37).

It would have been obvious to incorporate into the method of Foladore the teachings of Steinberg since it allows for the rental of a digital camera wherein the use is restricted to encourage the return of the camera.

**9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare and Steinberg as applied to claim 28 above, and further in view of Shiota..**

**Regarding Claim 29:**

Neither Foladore nor Steinberg disclose transmitting an picture image. However, Shiota discloses transmitting an picture image (Figs. 1-3).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Shiota into the method of Foladore and Steinberg because it allows for the storage and utilization of pictures taken with a rented digital camera.

**Regarding Claim 30:**

Shiota further discloses a method wherein the transmission comprises any one of an email, the FTP in the TCP/IP, or the command transfer of the HTTP (Fig. 1.) Furthermore, transferring images by email, TCP/IP and HTTP is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made since it is common every day practice to transmit images this way.

**10. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knolls (US Patent 6,606,602) (hereinafter referred to as Knolls).**

**Referring to Claims 26 and 27:**

Knolls discloses a device (for use with digital cameras, col. 5, lines 46-63) comprising a lock switching unit for switching operation possible/operation impossible (col. 9, lines 29-44) and a device comprising a display unit (Figs. 3a-3g), wherein the device transmits a lock signal to said lock switching unit when the reserved time is over (col. 9, lines 29-44, counter/timer)

The fact that the display unit is for displaying the rest of a reserved time is directed to an intended use of the display unit and does not result in structural or functional differences with respect to prior art.

***Response to Arguments***

11. Applicant's arguments filed July 21, 2004 have been fully considered but they are not persuasive.

The applicant argues that Foladare does not teach or suggest the claimed feature of an image transmission unit configured to transmit an input image data form an information device.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the image transmission unit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant's claim language is the client terminal comprises an image transmission designating unit configured to transmit an input image for the information device. An image is a broad term and would encompass an approval code transmitted over the network or a refusal.

Furthermore, the system in Foladare is a network. And therefor the image device is connected to the network.

A network is defined in OneLook.com as Main Entry:

**1 net·work**

Pronunciation: 'net-'w&rk

Function: noun

**1** : a fabric or structure of cords or wires that cross at regular intervals and are knotted or secured at the crossings

**2** : a system of lines or channels resembling a network  
**3 a** : an interconnected or interrelated chain, group, or system <a *network* of hotels> **b** : a system of computers, terminals, and databases connected by communications lines

**4 a** : a group of radio or television stations linked by wire or radio relay **b** : a radio or television company that produces programs for broadcast over such a network

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation has been found in the references. The Examiner directs the applicant to column 2, lines 26-34 and column 3, lines 12-31 in Shiota, column 1, lines 58-59 and column 2, lines 39-45 in Steinberg,

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

  
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